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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,076	09/04/2003	Geoffrey B. Rhoads	P0876	8345

23735 7590 06/28/2005

DIGIMARC CORPORATION
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EXAMINER

JOHNS, ANDREW W

ART UNIT PAPER NUMBER

2621

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,076

Applicant(s)

RHOADS

Examiner

Andrew W. Johns

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10Mar2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 9-11 of the response, filed 10 March 2005, with respect to the disclosure support for claim(s) 21-36 have been fully considered and are persuasive.

5 Therefore, Zhao (US 6,487,301 B1) has been withdrawn as prior art. However, upon further consideration, a new ground(s) of rejection is made in view of Nagato (JP 3-185585 A).

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

10 A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15 3. Claims 21-24, 29-32 and 35-36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nagato (JP 3-185585 A).

20 With respect to claim 21, Nagato teaches a method of authenticating an identification document (i.e., an ID card; English translation, page 2, lines 38-44), wherein the document comprises a photographic image of an authorized bearer of the document (i.e., a facial photograph; English translation, page 2, line 41) and machine readable code (i.e., personal data recorded in the photograph; English translation, page 9, lines 28-36), said method comprising obtaining data representing the machine readable code (i.e., reading data recorded in the photograph; English translation, page 4, line 22), wherein the machine readable code comprises a first portion including information corresponding the authorized bearer of the document (i.e.,
25 person's name; English translation, page 3, line 7), and a second portion including information

corresponding to a jurisdiction or issuer that issued the identification document (i.e., issuance number; English translation, page 3, line 9); and determining the authenticity of the identification document with reference to at least the first portion and the second portion (English translation, page 4, lines 19-25). In addition, Nagato also teaches that the machine readable code is provided
5 on the identification document so that its presence is not readily apparent to human observers of the identification document (English translation, page 9, lines 33-34), yet can be detected from optical scan data generated by optical scanning of the identification document (English translation, page 9, line 40 through page 10, line 13), as further required by claim 22; and that the machine readable code comprises a steganographic digital watermark (Figure 6(b), for example),
10 as variously stipulated by claims 23 and 24.

Regarding claim 29, Nagato teaches a method of providing an identification document (i.e., an ID card; English translation, page 2, lines 38-44) comprising providing a photographic image of an authorized bearer of the document on a document surface (i.e., a facial photograph; English translation, page 2, line 41); and providing a machine readable code on the identification
15 document (i.e., personal data recorded in the photograph; English translation, page 9, lines 28-36), wherein the machine readable code comprises a first portion including information corresponding the authorized bearer of the document (i.e., person's name; English translation, page 3, line 7), and a second portion including information corresponding to a jurisdiction or issuer that issued the identification document (i.e., issuance number; English translation, page 3,
20 line 9); whereby authenticity of the identification document is determined with reference to at least the first and second portion (English translation, page 4, lines 19-25). In addition, Nagato also teaches that the machine readable code is provided on the identification document so that its presence is not readily apparent to human observers of the identification document (English

translation, page 9, lines 33-34), yet can be detected from optical scan data generated by optical scanning of the identification document (English translation, page 9, line 40 through page 10, line 13), as further required by claim 30; that the machine readable code comprises a steganographic digital watermark (Figure 6(b), for example), as variously stipulated by claims 31 and 32; and an identification card provided according to the method (Figure 6(a), for example), as variously required by claims 35 and 36.

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25-28 and 33-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagato as applied to claims 21-24, 29-32 and 35-36 above, and further in view of Powell et al. '788 (US 5,721,788 A).

While Nagato meets a number of the limitations of the claimed invention, as pointed out more fully above, Nagato fails to specifically teach a computer readable medium comprising executable instructions stored thereon to implement the method, as variously required by claims 25-26 and 33-34, or an apparatus comprising electronic processing circuitry and memory comprising instructions implementing the method, as variously defined by claims 27-28. However, Powell et al. '788 teaches the use of a programmed computer (Figure 1) that includes electronic circuitry and instructions stored in a computer memory (column 2, line 60 through column 3, line 8) to authenticate documents using information embedded therein (column 2,

lines 34-59). Because both Nagato and Powell et al. '788 are directed towards reading information embedded in documents for authentication purposes, and because the use of a programmed computer of Powell et al. '788 provides a flexible and inexpensive means for implementing such techniques, it would have been obvious to one of ordinary skill in the art to
5 implement the techniques of Nagato using such components.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

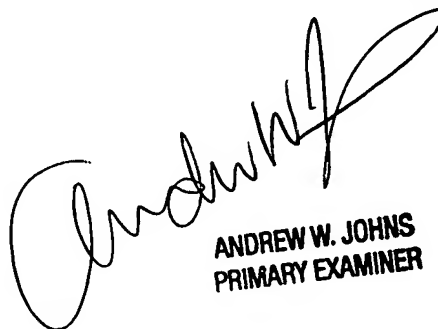
10 A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R.
15 § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

20 7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Johns whose telephone number is (571) 272-7391. The examiner is normally available Monday through Friday, at least during the hours of 9:00 am to 3:00 pm Eastern Time. The examiner may also be contacted by e-mail using the address: andrew.johns@uspto.gov. (Applicant is reminded of the Office policy regarding e-mail communications. See M.P.E.P. § 502.03)

25 If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Joseph Mancuso, can be reached at (571) 272-7695. The current fax phone number for this art unit is (703) 872-9306. However this number is scheduled to change and beginning July 15, 2005,

faxes should be sent to (571) 273-8300. In order to ensure prompt delivery to the examiner, all unofficial communications should be clearly labeled as "Draft" or "Unofficial."

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center Receptionist whose telephone number is (571) 272-2600.



ANDREW W. JOHNS
PRIMARY EXAMINER

A. Johns
24 June 2005